

## REMARKS

Reconsideration of the present application is respectfully requested in view of the following comments.

1. Rejection of Claims 1-9, 11, 13-14 and 16 under 35 U.S.C. § 103(a) as being Obvious over U.S. Patent 5,991,739 (Cupps et al.) in View of U.S. Patent 6,539,080

Claims 1-9, 11, 13-14 and 16 currently stand rejected as being obvious over the disclosure of Cupps et al. in view of the Bruce et al. disclosure. Applicant respectfully traverses this rejection on the basis that the Cupps et al. and Bruce et al. disclosures, whether considered collectively or individually, fail to describe or suggest a method for searching information on the Internet, as recited in claim 1 of the present application. Claims 2-9, 11, 13-14 and 16 are thus patentable based on their dependency from claim 1 and their individually recited features.

- a. Claim 1 of the Present Application

Claim 1 generally relates to a method for searching information on the internet. The method comprises using at least one search assistant to help a user when searching for information on the internet, wherein such human search assistant is human and a specialist in searching on the internet.

- b. Cupps et al. Disclosure

In the Action, the Background of the Invention in the disclosure of Cupps et al. is used as a basis for the rejection of the above-identified claims. Applicant submits that there is simply no disclosure or suggestion in the disclosure of Cupps et al. of using "a human search assistant" to assist a user when searching on the Internet. While the Action indicates that the PizzaNet described by the Cupps et al. disclosure is "represented as a human search assistant," the Cupps et al. disclosure makes no

such description, whether implicitly or explicitly. Instead, the PizzaNet is described along with other Internet services that provide customers with access to menus for products that can be ordered online (col. 1, lines 9-12). While customers enter personal information to obtain menus in a specific geographical area, such information is apparently used in an automated process whereby the PizzaNet then provides a menus list of participating pizza restaurants within the specific geographical area. *Nowhere is there any disclosure or suggestion of a human deliberately providing assistance in providing such list of menus.*

The Cupps et al. disclosure makes it known that a shortcoming of the PizzaNet is that its primary method of communication with a restaurant is through a facsimile machine (col. 2, lines 9-11). Moreover, once the order is made on the Internet, subsequent communication between a customer and the delivery system is performed via telephone calls (col. 2, lines 14-16). At this stage in the ordering process, however, the customer has presumably completed use of the PizzaNet by having already selected a restaurant and ordered food by such restaurant.

*In the PizzaNet system, it is left to the user to search which restaurants are desired. The user of the PizzaNet system can review each menu to determine what is desired. If a live operator were used, it is unclear from the comments in the Action what such operator would do other than replace the PizzaNet system itself.*

These observations beg the question how it may be asserted in the Office Action that the PizzaNet is represented as a human search assistant when the only human involvement in using the PizzaNet is the actual customer entering personal information, selecting from a list of menus based on the entered personal information, and ordering from a selected menu. Since there is no disclosure of a human providing assistance to a customer using the PizzaNet in making an order via the Internet, it bewilders the Applicant how the Cupps et al. disclosure can be construed to teach such a proposition.

When properly interpreted, the PizzaNet described by Cupps et al. merely is an automated Internet search tool that permits food products to be ordered online. Indeed, the Cupps et al. disclosure does not discuss or show a human search assistant, but instead briefly describes an automated search and ordering system. Thus, even an artisan of ordinary skill must guess about how exactly the PizzaNet system would incorporate a human search assistant and why a human search assistant would even be desirable if everything that the PizzaNet system provides is automated. In fact, the Cupps et al. disclosure makes no suggestion of any kind about the suitability for a human search assistant. About the most that can be said for the Cupps et al. patent is that it is silent in respect to a human search assistant. However, it is well understood that a negative pregnant is not enough to show anticipation or obviousness.

Thus, the Cupps et al. disclosure does not describe or suggest the method of claim 1 of the present application.

c. Bruce et al. Disclosure

In the Action, the disclosure of Bruce et al. has been proffered to make up for the shortcomings of the Cupps et al. disclosure. Namely, the Action fully admits that the Cupps et al. disclosure fails to teach the provision of claim 1 of the present application in that "at least one search assistant is human and a specialist in searching on the Internet." Applicant respectfully disagrees that the Bruce et al. disclosure furnishes a description or suggestion that when combined with the disclosure of Cupps et al. would tend to motivate one skilled in the art to execute or devise the method recited in claim 1 of the present application.

More specifically, the Bruce et al. disclosure describes a method and system for providing a telephone caller information assistance, such as driving directions. To obtain the assistance, the caller places a telephone call to access the system. After obtaining street route driving instructions, the call can be transferred to an

audio box having an interactive user interface capable of replaying the desired information to a caller.

Nowhere in the Bruce et al. disclosure is there a description or suggestion of an operator assisting a user in searching information on the Internet. While it is true that the caller may obtain the driving instructions in different ways from receiving them over a telephone, the Bruce et al. disclosure only describes a caller initiating a demand for instructions by calling an operator.

The Bruce et al. disclosure makes it abundantly clear that the method and system disclosed therein is distinguished in that it provides instruction to a caller who does not have ready access to the Internet (col. 1, lines 25-30). It is described that a caller would have little use of Internet-based searching tools since the method and system of Bruce et al. is described in the context of providing driving directions while the caller is driving. In addition, there is no description provided by the Bruce et al. disclosure that suggests the need for human assistance when searching on the Internet. Instead, it appears that the Bruce et al. disclosure considers the Internet map tools as fully adequate without human assistance (col. 1, lines 13-30).

*Thus, the method and system of Bruce et al. does not anticipate or make obvious a method wherein a user accesses the Internet and receives assistance from a human search assistant.*

d. Combination of the Cupps et al. and Bruce et al. Disclosures

Applicant submits that the Cupps et al. and Bruce et al. disclosures, whether considered collectively or individually, fail to disclose or suggest each and every feature recited in claim 1 of the present application. For the reasons discussed below, Applicant submits that the combination of the Cupps et al. and Bruce et al. disclosures fail to render claim1 unpatentable.

To establish obviousness under 35 U.S.C. § 103(a), differences between the subject matter sought to be patented and the prior art reference are such that the subject matter as a whole would have been obvious to one skilled in the art at the time of the invention. Accordingly, in making an assessment of differences, section 103 specifically requires consideration of the claimed invention as a whole guided by the accepted wisdom at the time the invention was made. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d 1686, 1689.

Identification of each element of a claimed invention in prior art references is insufficient to defeat patentability of the whole claimed invention. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching to select and combine the references relied on as evidence of obviousness. *In re Lee*, 277 F.3d 1338, 1342-43, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001)).

In making a rejection based on obviousness, particular findings and specific reasons must be provided as to why a skilled artisan would have been motivated to select references and to combine them to render a claimed invention obvious. See *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); See also *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). Evidence of the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Whether an express or implicit showing is relied upon, particular findings related thereto must be provided therewith. When general knowledge is relied upon to negate patentability, that knowledge must be articulated in the record and cannot

be resolved on "subjective belief and unknown authority." *Lee*, 277 F.3d at 1342-1345, 61 U.S.P.Q.2d at 1433-35.

The Cupps et al. disclosure describes an automated Internet search and ordering system and the PizzaNet system has been identified as a system akin to the system of claim 1 of the present application. On the other hand, the Bruce et al. disclosure describes a method and system for providing directions via a telephone. The Action appears to select the telephone system of the Bruce et al. disclosure, and proposes to incorporate the system of Bruce et al. with the PizzaNet described by the Cupps et al disclosure.

There is no evidence provided in the Cupps et al. disclosure as to the desirability of employing an operator to assist in searching for a restaurant in the PizzaNet system. Indeed, if an operator were used to search for a restaurant in accordance with the PizzaNet system in the Cupps et al. disclosure, there would likely be no need for the PizzaNet system since the operator would effectively perform the same task.

The Action asserts that in view of the teachings of the Cupps et al. and Bruce et al. disclosures, one of ordinary skill in the art would have been motivated to make the method of claim 1 of the present application. The rationale for the motivation proffered by the Action is that a live operator as described in the system of the Bruce et al. disclosure would have saved time for a user of the PizzaNet system described in the Cupps et al. disclosure. The Examiner's rationale does not find any support in the prior art references themselves, as they are not directed to problems related to time economy. Also, the Examiner fails to acknowledge that if a live operator were used in conjunction with the PizzaNet system described in the Cupps et al. disclosure, the live operator would obviate the need for the PizzaNet system since this system takes information from a user and automatically provides a list of restaurants local to the user and access to menus of such restaurants.

The statements in the Action regarding the motivation or desirability to combine the Cupps et al. and Bruce et al. disclosures are conclusory in nature and fail to address the adequacy of motivation to combine these references. The rationale in the Action for combining the Cupps et al. and Bruce et al. disclosures is not based on objective evidence, but is instead grounded on subjective belief and unknown authority. Thus, the Action has failed to provide requisite findings of motivation to modify the Internet search and ordering system described in the Cupps et al. disclosure with the teachings of the Bruce et al. disclosure. Moreover, the Action fails to explain the reasoning by which the findings are deemed to support the Examiner's conclusion. See *e.g.*, *Lee*, 277 F.3d at 1345, 61 U.S.P.Q. at 1434.

It is therefore submitted that the motivations provided in the Action to combine the teachings of the Cupps et al. and Bruce et al. disclosures are not taken from the prior art references themselves, but instead appear to be taken from Applicant's disclosure or are merely fabricated.

Thus, this rejection does not meet the requirements of 35 U.S.C. § 103(a).

Accordingly, in view of these observations, Applicant respectfully requests withdrawal of the rejection of claims 1-9, 11, 13-14 and 16.

2. Rejection of Claims 10 and 15 under 35 U.S.C. § 103(a) as Being Obvious over U.S. Patent 5,991,739 (Cupps et al.) in view of U.S. 6,569,080 (Bruce et al.) and Further in View of U.S. Patent 5,898,594 (Leason et al.)

Claims 10 and 15 presently stand rejected in view of the combination of the Cupps et al., Bruce et al. and Leason et al. disclosures. Claims 10 and 15 depend from claim 1 which was distinguished above in view of the combination of the Cupps et al. and Bruce et al. disclosures.

Applicant respectfully submits that the Leason et al. disclosure fails to make up for the shortcomings discussed above in reference to the Cupps et al. and Bruce et al. disclosures. More specifically, the disclosure of Leason et al. fails to provide any teaching that would provide motivation to include a human search assistant for assisting a user to search for documents on the Internet.

Accordingly, the Cupps et al., Bruce et al. and Leason et al. disclosures, whether considered collectively or individually, fail to disclose or suggest the features recited in claim 1 and claims 10 and 15 of the present application. Withdrawal of this rejection is respectfully requested.

3. Rejection of Claim 12 under 35 U.S.C. § 103(a) as Being Obvious over U.S. Patent 5,991,739 (Cupps et al.) in View of U.S. 6,569,080 (Bruce et al.) and Further in View of U.S. Patent 5,913,214 (Madnick)

Claim 12 presently stand rejected in view of the combination of the Cupps et al., Bruce et al. and Madnick et al. disclosures. Claim 12 depends from claim 1 which was distinguished above in view of the combination of the Cupps et al. and Bruce et al. disclosures.

Applicant respectfully submits that the Madnick et al. disclosure fails to make up for the shortcomings discussed above in reference to the Cupps et al. and Bruce et al. disclosures. More specifically, the disclosure of Madnick et al. fails to provide any teaching that would provide motivation to include a human search assistant for assisting a user to search for documents on the Internet.

Accordingly, the Cupps et al., Bruce et al. and Madnick et al. disclosures, whether considered collectively or individually, fail to disclose or suggest the features recited in claim 1 and claim 12 of the present application. Withdrawal of this rejection is respectfully requested.

4. Conclusion



Application No.: 09/922,811  
Examiner: Cam Y. T. TRUONG  
Art Unit: 2172

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-16 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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